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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,655	04/27/2001	Haruhiko Kinoshita	048369/0122	7697
22428	7590	09/20/2006	EXAMINER	
FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			OUELLETTE, JONATHAN P	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/842,655

Applicant(s)

KINOSHITA, HARUHIKO

Examiner

Jonathan Ouellette

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 November 2005 and 18 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Amendment*

1. Claims 1-9 have been cancelled; therefore Claims 10-24 are currently pending in application 09/842,655.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 10-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Vargas et al. (US 2002/0046187 A1).**

4. As per **independent Claims 10, 16, and 23**, Vargas discloses a method, comprising:  
sending at least non-public business information from a candidate enterprise terminal (potential seller information) to an application service provider over a communication network, said non-public business information including at least non-public financial, accounting, and tax information of a candidate enterprise (Abstract, Fig.3, Para 0020-0022), Confidential Full Disclosure information); storing, by said application service provider server, said non-public business information; sending said non-public business

information from said application service provider server to a merger and acquisition brokering business entity terminal over said communication network in response to a request from said merger and acquisition brokering business entity terminal (Para 0023); and generating, by said merger and acquisition brokering business entity terminal, a merger or acquisition proposal based on said non-public business information, said merger or acquisition proposal being a proposal that specifies terms for a merger or an acquisition related to said candidate enterprise (Para 0023, matching opportunities).

5. As per Claim 11, 18, and 24, Vargas discloses sending at least second non-public business information from a second candidate enterprise (potential buyer information) terminal to said application service provider server over said communication network, said second non-public business information including at least non-public financial, accounting, and tax information of a second candidate enterprise; storing, by said application service provider server, said second non-public business information; sending said second non-public business information from said application service provider server to said merger and acquisition brokering business entity terminal over said communication network in response to a second request from said merger and acquisition brokering business entity terminal; and generating, by said merger and acquisition brokering business entity terminal, a second merger or acquisition proposal based on said second non-public business information, said second merger or acquisition proposal being a second proposal that specifies terms for a second merger or a second acquisition related to said second candidate enterprise (Para 0020-0022).

6. As per Claim 12 and 19, Vargas discloses wherein said step of sending at least non-public business information from a candidate enterprise terminal to an application service provider server over a communication network, comprises: periodically sending (updating) non-public business information from a candidate enterprise terminal to an application service provider server over a communication network, said non-public business information including at least non-public financial, accounting, and tax information of a candidate enterprise (Para 0021-0022, updatable profile information).
7. As per Claim 13 and 20, Vargas discloses wherein said communication network is the Internet (Para 0020, server communication).
8. As per Claim 14 and 21, Vargas discloses wherein said application service provider server comprises a computer; wherein said candidate enterprise terminal comprises a computer; and herein said merger and acquisition brokering business entity terminal comprises a computer (Para 0020-0022).
9. As per Claim 15 and 22, Vargas discloses wherein said non-public business information has not been made public (Para 0021-0023, confidential information exchanged).
10. As per Claim 17, Vargas discloses sending said merger or acquisition proposal from said merger and acquisition brokering business entity terminal to said candidate enterprise terminal (Para 0023, send list of opportunities).

***Response to Arguments***

11. Applicant's arguments filed 5/18/2006, with respect to Claims 10-24, have been considered but are moot in view of the new ground(s) of rejection.

12. Applicant's amendment (11/8/2005) necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
13. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

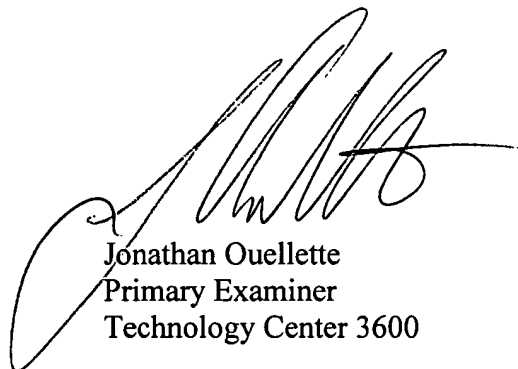
### *Conclusion*

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.
15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (571) 273-8300 for all official communications.

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16. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Office of Initial Patent Examination whose telephone number is (703) 308-1202.

September 15, 2006



Jonathan Ouellette  
Primary Examiner  
Technology Center 3600